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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,706	05/29/2001	Takanori Yamazaki	1341.1094	5744

21171 7590 01/10/2007  
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WASHINGTON, DC 20005

EXAMINER
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O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/865,706

Applicant(s)

Yamazaki

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 12, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 5, and 7 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 29, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2006 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the arguments and request for reconsideration filed by applicant on December 12, 2006 in reply to the previous Office action on the merits, mailed July 13, 2006.

3. Claims 1, 3, 5, and 7 remain pending, claims 2, 4, 6, and 8-12 having been previously cancelled by applicant.

***Claim Rejections - 35 USC § 101***

4. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. To be considered statutory, claimed subject matter requires four things<sup>1</sup>:

(1) the claimed subject matter *must* lie within the ambit of the *four classes* of statutory subject matter enumerated in 35 U.S.C. 101, those being any new and useful *process, machine, manufacture, or composition of matter*;

(2) the claimed subject matter *must not* fall within any of the *three categories* of statutory subject matter *exceptions* enumerated by the courts, those being, *in the absence of any practical application: abstract ideas, laws of nature, and natural phenomena*;

(3) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must not preempt* the underlying abstract ideas, laws of nature, or natural phenomena by foreclosing others from *substantially all other practical applications* of the *same* abstract ideas, laws of nature, or natural phenomena; *and*,

(4) any *practical application* of one of the three *otherwise nonstatutory* categories of exceptions *must* be evidenced in at least one of two possible ways:

(a) by transforming an article or physical object to a different state or thing; or,

(b) by otherwise producing any useful, concrete, and tangible result.

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<sup>1</sup> *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, published by order of the Commissioner for Patents, available in pdf format online on the Internet at: [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

6. Claims 1, 3, 5, and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 3, 5, and 7, all of which can be performed entirely mentally and/or manually are drawn to an abstract idea and comprise simply a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any "useful, concrete, and tangible result." *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754, 1760 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boardman et al. (US 6,456,986).

Boardman et al. disclose a support fee setting method comprising multiple grades of service for users (each user inherently having a userid in order to be stored in a user database), obtaining the grade of a user by referring to a user information database, and setting a support fee based on the grade of the user, but Boardman et al. specifically disclose neither a point system

with a point-to-grade conversion table, nor including the actual cost for responding to an inquiry from a user in the determination of the support fee.

However, a point system with a point-to-grade conversion table, and basing a fee on an actual cost, are two well known, hence obvious, elements to include in any method of setting a fee/pricing structure, and official notice to that effect is hereby taken. For example, each “point” could be just one minute of support time, each “grade” could be a level of minutes (i.e., up to 30 minutes, up to 60 minutes, etc.), and including the “actual cost” could be as simple as entitling a user of a particular grade to a particular percentage level of discount (e.g., additional, overage minutes costing more per minute for a 30-minute-plan customer than for a 60-minute-plan customer).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Boardman et al. so as to use a point system with a point-to-grade conversion table, and to include the actual cost for responding to an inquiry from a user in the determination of the support fee, as is well known to do, in order to increase revenue by enticing customers into purchasing excess support coverage in order to avoid shortfalls, similar to the pricing scheme/model commonly used with mobile phones.

Regarding claims 3, 5, and 7, all of the recited features are found directly in the disclosed method of Boardman et al., or they are inherently present in the modification described above, or they are of such a minor difference that their inclusion would have been self-evident/obvious to one of ordinary skill in the art, at the time of the invention, simply as a matter of design choice, since their inclusion could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

***Response to Arguments***

9. Applicant's arguments filed December 12, 2006 have been fully considered but they are not deemed persuasive.

10. Regarding the arguments *vis-à-vis* the *State Street* case, the *State Street* case is not pertinent to the matter at hand because the *State Street* case applied to a *machine-implemented* method, while the instant claim are drawn to a *not-necessarily-machine-implemented* method, which requires an entirely different analysis in terms of statutory subject matter.

11. Regarding the arguments that the claims are directed to statutory subject matter because they are directed to a "computed" "support fee" and are therefore statutory "for the same reasons the claims considered in *State Street* are statutory, the instant claims are not directed to statutory subject matter because, unlike the claims of *State Street*, the instant claims do not *require* any computer, since "computing" *per se* can be performed either by a computer or simply mentally. Therefore the instant claims are directed merely to an abstract idea.

12. Regarding the argument that the recited method step of "outputting" renders the claims statutory, the recited method step of "outputting" does not render the claims statutory because "outputting" could be as little as a person speaking/saying the amount that the person had calculated mentally in their head.

13. Regarding the argument that the specification describes a machine-implemented embodiment of the claimed invention, and so the *State Street* case applicable to machine-implemented methods should apply in the instant matter, it is noted that the features upon which applicant relies (i.e., machine-implemented) are not required by the rejected claim(s). Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Regarding the arguments against the Boardman et al. reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. Regarding the arguments with respect to the prior art, note that the arguments are considered moot because the claims are directed to non-statutory subject matter, and therefore cannot be allowed. Prior art has been applied in the interest of compact prosecution, but any prior art rejections applied now might or might not remain appropriate against materially different future claims amended so as to overcome the rejection of the instant claims under 35 U.S.C. 101.

16. Regarding the argument that Boardman et al. is directed to a system for charging users for making telephone calls, not a system for providing “computer support activity,” and a “telephone call does not correspond to an inquiry with a computer support activity,” providing support



coverage by means of telephone calls is ubiquitous in the art. Moreover, it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory.

See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

17. Regarding the arguments concerning well known prior art (official notice), MPEP

§ 2144.03(C) states (in part):

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

In this case, applicant's prior traversal was inadequate, and the examiner included an explanation as to why it was inadequate. Therefore, the object of the well known statement has since been deemed admitted prior art, as explained in MPEP § 2144.03(C), and, in accordance with compact prosecution, any further such arguments or traversals are no longer considered seasonable. See MPEP § 2144.03.

18. Regarding the argument that the examiner has improperly used official notice as the "principal evidence" for the rejection, the examiner has not improperly used official notice as the principal evidence for the rejection. The term "principal evidence" refers to the primary reference applied in a rejection, in this case the patent to Boardman et al.

19. Regarding the argument that the rejection is based on personal knowledge of the examiner, no rejections in the instant application are based, in whole or in part, on personal knowledge of the examiner--that is, knowledge that is not well known or commonly known, but that is solely in the possession of the examiner (i.e., the exact opposite of what was stated in the rejection).

20. Regarding the argument that simply because one *could* combine or modify references does not *necessarily* mean that such a combination or modification can *automatically* be considered obvious, applicant is correct. However, the main test for obviousness in such a case is whether or not one of ordinary skill in the art would be readily and easily able to make the proposed combination or modification, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

The instant invention is considered obvious because the proposed combinations/modifications, in accordance with this test, could indeed all be made readily and easily by one of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

21. Regarding the argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to the disclosure.

23. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


24. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

January 8, 2007



1/8/07

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627